

## **REMARKS**

### **I. Pending Claims**

Claims 1 through 4 and 6 through 46 are pending in this application.

Claims 1, 11, 13-15, 17, 18 and 20 have been amended, claim 5 has been cancelled without prejudice or disclaimer of its subject matter, and claims 21 through 46 have been newly added.

### **II. Premature Office Action**

The applicant had filed three preliminary Amendments on 29 October 2001, 14 December 2001, and 22 October 2002. In the first Office action mailed on April 23, 2003 (Paper No. 8), the examiner did not consider all of the preliminary Amendments. On a phone discussion on 7 May 2002, the examiner stated that she received a first and a third Preliminary Amendment, but did not receive a second Preliminary Amendment. The applicant submits the copy of the second Preliminary Amendment filed on 14 December 2001 and the postcard receipt herewith. The second Preliminary Amendment should have been entered.

This Response and Amendment are made on the basis that the Commissioner has correctly entered all of the previous three preliminary Amendments were entered. As such, this Office action is premature. Entry of the foregoing amendments to the claims, drawings, Abstract and specification, and entry of all three of Applicant's Preliminary Amendments, prior to examination, are respectfully requested.

### **III. Drawings**

The drawings were objected to (1) as failing to comply with 37 CFR 1.84(p)(5) because they did not include the following reference signs mentioned in the description:  $\omega$ , 33, 34 and 53. The examiner further stated that Figure 1 should be designated by a legend such as --Prior Art--. The examiner also stated that there is a lead line without an associated reference character in Figure 3 to the right of reference character 21.

The original Fig. 3 includes "34". In the second Preliminary Amendment accompanied with the Office Draftsman, "33" and "53" were inserted in Fig. 3 and Fig. 4, respectively and the lead line has an associated reference numeric, "33". Therefore, the examiner's objections regarding the reference numeric "33," "34" and "53," and the non-associated lead line are not proper.

The Fig. 3 has been corrected by inserting the symbol " $\omega$ ," and to identify the *closure axis* "A" mentioned throughout the specification. A substitute sheet of formal drawings including these changes accompany this Amendment.

### **IV. Labeling Of Drawings**

Applicant respectfully traverses the Examiner's suggestion that Figure 1 be labeled as "Prior Art". In support of this suggestion, the Examiner states that "*only* that which is *old* is illustrated." The Examiner's statement is factually incorrect and legally flawed.

**First**, Figure 1 illustrates Applicant's analysis of a structure found in the prior art; Figure 1 itself is not prior art, but is a new analysis that was not previously available to the public. Consequently, labeling Figure 1 as "prior art" would be inaccurate and misleading, because Figure

1 serves to comply with the requirements of 37 CFR §1.83(a) and (b).

**Second**, identifying Figure 1 as prior art would denigrate both Applicant's contribution to the art, and Applicant's recognition of the flaws intrinsic in the prior art and erect a bar to patentability contrary to 35 U.S.C. §103(a), which expressly states that "patentability should not be negative by the manner in which the invention was made by Applicant. Accordingly, reconsideration and withdrawal of the Examiner's suggestion to label Figure 1 as "prior art" are respectfully requested.

**Third**, the Examiner's justification is flawed. The term *Prior Art* was defined by the Congress of these United States in 35 U.S.C. §103(a) by reference to the several sections of 35 U.S.C. §102. Nothing in 35 U.S.C. §102 states that the fact that a drawing is *old* makes that drawing *Prior Art*. The fact that Applicant illustrated deficiencies in a prior art structure, which deficiencies Applicant alone both recognized and addressed, does not make Applicant's illustration of those deficiencies prior art, even when those deficiencies that are illustrated are found in a structure that is itself prior art under one, or more, sections of 35 U.S.C. §102. Consequently, there is no basis for the Examiner's requirement and withdrawal of the Examiner's requirement is necessary.

#### **V. Specification**

1. The examiner stated that the abstract of the disclosure is objected to because it contains the objectionable phrase "the invention relates to" and the term "means."

Although the abstract contains the term "means," it is used as a phrase "by means of," not as a means plus function clause. The abstract has been amended to delete those terms to avoid

confusion:

2. The examiner stated that the title of the invention is not descriptive, and that a new title is required that is clearly indicative of the invention to which the claims are directed.

The title has been amended to "Closure Having Hinge Connections For A Container." The new title is believed to be descriptive and proper.

Withdrawal of the rejection is respectfully requested.

3. The disclosure was objected to because of the informalities.

With respect to "upper closure part," the specification has been amended to refer to "upper closure part" as one reference numeral "22." The specification has also been amended to refer to the reference numeral "57" as "catch." The specification has been amended to refer the reference numeric "23.1," and "23.2" as "connecting elements," and the reference numeral "39" as "coupling element."

Applicant has amended the specification in four instances to correspond to the correction of Figure 3, and to identify *closure axis "A"*.<sup>1</sup> The Examiner's attention is invited to note that *closure axis "A"* is different from the *hinge axis*.<sup>2</sup>

## **VI. Claim Objections**

Claims 1-10 were improperly objected to based upon the Examiner's assertion that these claims lack an indefinite article at the beginning of each statement and the phrase "Patent Claim."

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<sup>1</sup> Original Specification, page 8, line 5, among other locations.

<sup>2</sup> Original Specification, page 6, line 8.

Applicant's second Preliminary Amendment filed on 14 December 2001, presents claims 1 through 10 in grammatically correct format.

Withdrawal of the objection is respectfully requested.

#### **VII. Claim Rejections - 35 U.S.C. §112**

Claims 1-10 were improperly rejected under the second paragraph of 35 U.S.C. §112, as being indefinite and as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner asserted that the structure of the closure is not clearly set forth in claim 1, and, specifically, it is unclear what is intended by "two hinge connections each which border non-adjacent sides of said elements."

This phrase is not present in the claims pending before the Examiner. Consideration of Applicant's second Preliminary Amendments is respectfully requested.

The examiner asked the applicant about two hinge connections, the connecting element, the two places of claim 8. These terms are not found in claim 8 as pending as of the date of Paper No. 8.

The examiner asserted that the phrase "means of two hinge connections" fails to meet the 3-prong analysis of a "means plus function." Since the term "means" was not intended to use as a means plus function clause, the examiner's assertion is not proper. To avoid any confusion, the phrase "by means of" has been deleted.

**VIII. Claim Rejections - 35 U.S.C. §102**

Claims 1, 2 and 5-10 were rejected under 35 U.S.C. §102(b) as being anticipated by Nozawa (US 5,148,912). The examiner further asserted that claim 1 is a product-by-process claim and “the hinge connections being accessible in the mold from the inside of the closure and from outside the closure” does not structurally limit the finished claimed product. Applicant respectfully traverses this rejection for the following reasons.

**First**, the examiner has a burden of providing a rationale tending to show that the claimed product appears to be the same of the prior art. Here, the examiner merely asserted that Nozawa ‘912 anticipates the claims 1, 2 and 5-10, and did not show which disclosure in Nozawa ‘912 correspond to the elements and limitations recited in claims 1, 2 and 5-10. The Examiner has failed to comply with the particularity and completeness suggested by the Commissioner in 37 CFR §1.104(b) and (c). Nozawa ‘912 discloses four substantially different embodiments; the Examiner has not specified which embodiment of Nozawa ‘912 has been applied to support this anticipation rejection. These four embodiments of Nozawa ‘912 are not identical and do not have interchangeable component elements. Clarification is respectfully requested.

**Second**, as rejected, claim 1 defines a structure with Applicant’s hinge connections making a first angle with one another, and having the two pairs of hinge connections defining planes which “make a second angle  $\omega$  with one another, wherein, in a closed position of the closure, the planes are inclined relative to a closure axis.”

In contradistinction, Figures 3, 8, 10 and 11 show that each of the four embodiments taught by Nozawa ‘912 incorporate resilient belt plates 7, 7 could be that are isosceles trapezoids, that is,

trapezoids that have two non-parallel sides 7c, 7d of equal length. As explained in column 4, lines 8 through 17 of Nozawa '912, "both ends of the thin-walled hinges 10 at the lower side of each of the resilient belt plates are placed on a curved line 31 drawn to extend upwardly around the center of curvature of any point on a center line 30" and "both ends of the upper thin-walled hinges 11 are placed on a curved line 32 drawn to extend downwardly from a center curvature of any point on a center line 30 between the two resilient belt plate 7." In other words, curved lines 31 and 32 have the same radius of curvature, as is clearly illustrated in Figures 3 and 8, when the vertical side walls of main body 1 and lid 3 are extended vertically upward as tangents to curved line 32. It is important to understand however, that curved lines 31, 32 do not themselves lie in the same plane, but are oblique to the pages of Figures 3 and 8 and are cylindrically curved, rather than planar. As an example, a circle appears to remain a circle, regardless of whether that circle is viewed along a line perpendicular to its center, or obliquely to the center. Consequently, realizing that the closure axis of Nozawa's embodiments illustrated in Figures 3 and 8 lie along a plane that includes center line 30, and is perpendicular to the planes of Figures 3 and 8, the second angle formed by the pairs of hinge connections taught by Nozawa are parallel to, rather than inclined (as taught by Applicant's claim 1, to that closure access). In short, there is no anticipation of Applicant's pending claims 1 through 20.

**Third**, independent claims 1 and 34 define a structure and process, respectively, with the closure moulded in a closed position, as opposed to being moulded in an opened position as is taught by Nozawa '912. This is a specially significant improvement over the art, because, as is explained

on page 6, beginning with line 10 of Applicant's detailed description, Applicant alone both recognized and addressed a need in the art:

“to produce the closure 1 in the closed position of the upper closure part 3, the main hinge connection 5 in tension bands 6.1, 6.2 and in particular their connection to the closure parts 2 and 3 must be arranged in such a way that they are accessible in the injection mould (not shown) from the inside of the closure (arrow 10) **and** from the outside of the closure (arrow 11).”

Analysis of a cross-section taken perpendicularly through the structure shown in Fig. 3, or the structure shown in Fig. 4, when that structure is in a closed position, will reveal that from the inside of the mould, all elements of Applicant's closure are accessible in the mould; moreover, all of these elements are accessible in the mould from the outside and from the inside. This is further explained beginning on page 7, line 28 of Applicant's original disclosure, which states:

“to be able to produce the closure 20 in the closed position, the elements 23.1 and 23.2 and the hinge connections 24.1, 24.2, 25.1 and 25.2 are arranged in such a way that they are accessible in the mould from the inside of the closure (arrow 27) and from the outside of the closure (arrow 28) and can be removed from the mould. For this purpose, the connecting elements 23.1, 23.2, and the associated hinge connections are arranged in a surface which is inclined relative to the closure axis.”

In contradistinction, the structure of Nozawa '912 requires closed cavities between the upper and lower closure elements, when that structure is in its closed position. Consequently, not all of the elements of Nozawa '912 are accessible in the mould while in a closed position; consequently, Nozawa '912 fails to teach a structure that is amenable to moulding in the closed position. In view of this deficiency, claims 1 and 34 are readily distinguishable and allowable over the prior art.

Newly presented independent claims 21, 34, 38, 41 and 44 together with their dependent claims 22 through 33, 35 through 37, 39, 40, 42 and 43, and 45 and 46, respectively, provide an



alternative definition of this feature. Consequently, claims 21 through 46 are also deemed to be patentably distinguishable, and allowable, over the prior art.

For the foregoing reasons, the examiner's anticipation rejection is not proper.

**IX. Claim Rejections – 35 U.S.C. §103**

Claims 3 and 4 stand rejected under 35 U.S.C. §103 as being unpatentable over Nozawa '912 in view of Dubach (US 5,392,938).

The examiner asserted that Nozawa '912 taught the claimed closure except for at least one element initially connecting the two closure parts in the closed position, and that Dubach '938 taught that it was known to initially secure two hinged closure parts together.

Claims 3 and 4 depend effectively from claim 1. As stated above, the examiner did not show that each element and limitation of claim 1 is taught in Nozawa '912.

Therefore, the Examiner's rejection should be withdrawn.

**X. Claims 11-20 and 21-46**

Claims 11 through 20 added by Applicant's second Preliminary Amendment were not examined in Paper No. 8. Their consideration is respectfully requested.


Examination of claims 11 to 20 and newly presented claims 21 through 46, is also respectfully requested.

**XI. Fee**

A fee of \$702.00 is incurred by the addition of twenty-five (25) total claims in excess of 20 and three (3) independent claims in excess of 3. Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

  
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